

### **REMARKS**

This communication is submitted in response to the final Office Action dated January 25, 2007. Claims 1, 2, and 4-36 are currently pending in this application. Claims 1, 21, 28 and 32 are independent. Claims 1, 6, 21, 28, and 32 are currently amended. Claims 3 and 37 are canceled.

#### **Claim Objections**

Claim 6 is objected to under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Action states that claim 6 recites business information as being location information and that this is already recited in claim 1. Claim 6 has been amended above to obviate this objection. Applicants, therefore respectfully request that the objection to claim 6 be withdrawn.

#### **Rejection Under 35 U.S.C. § 102(e)**

Claims 1, 2, 4-6, 8-25, 27-29 and 32-36 are rejected as being anticipated by Mitsuoka, U.S. Patent App. No. 2002/0026355 ("Mitsuoka").

Certain embodiments of the present invention, provide systems and methods for Real-time Instant Presence with Advertisement (RIPA) using an instant messaging topology with wireless technology to instantly setup and update presence information of an instant messaging user. The systems and methods provide location information of a business and other business information to a wireless instant messaging user/customer of the business, and further provide methods for promotion, advertising and network marketing of a business using presence information sent to instant messaging users and instantly propagated through instant messaging address lists.

Accordingly, independent claim 1 currently recites a method of establishing presence information comprising, *inter alia*, storing business information identifying the business in a business client system device, retrieving the business information and transmitting all or part of the business information as presence information, **including physical location information**, to

the wireless device of the first instant messaging user, wherein the presence information is received by the wireless device of the first instant messaging user in response to a single action performed by the first instant messaging user.

Mitsuoka fails to teach or suggest the above-identified subject matter. Instead, Mitsuoka teaches a system that enables icons such as a company emblem to be set as a user status. As the Office Action indicates, the icons are set when the user comes to an outlet. Contrary to the position taken by the Office Action, however, the icons do not comprise presence information as required in amended claim 1. As currently recited in claim 1, the presence information includes **physical location information**. This physical presence information is stored in a business client system. Accordingly, the physical location information can later be retrieved from the business client system. The physical location information may comprise, e.g., an address, coordinates, etc., that is stored for later retrieval in a business client system. Mitsuoka, on the other hand, simply stores a symbol and "the symbol of the advertiser is set as a user status when the user comes to the outlet." See Mitsuoka paragraph [0062]. In other words, the symbol is set to indicate when a user is near the advertiser, e.g., when the user is in an outlet that contains the advertiser's store. **Mitsuoka does not store physical location information**; it simply lights up a symbol based on detecting wireless signals in an outlet mall. See Mitsuoka paragraph [0063].

Additionally, the Office Action indicates that the single action for receiving presence information is taught in Mitsuoka paragraph [0023], which sets forth an "icon set" button for a Web Page of an advertiser. When a user clicks the button, a user terminal accesses the awareness device and passes the icon file name, and the awareness device adds the passed icon file name to owned icons of the requesting user. In other words, Mitsuoka paragraph [0023] teaches a method for adding icons to a list of owned icons by a user. By contrast, claim 1 calls for a method of establishing presence information, wherein the presence information (including the physical location information) is received by the wireless device of the first instant messaging user in response to a single action performed by said first instant messaging user.

Independent claim 21 currently recites a "business client system for sending presence information with advertisement to a wireless instant messaging user,... whereby presence

information, *including physical location information*, for said wireless instant messaging user is updated." As set forth hereinabove with respect to claim 1, Mitsuoka's icons clearly do not comprise location information. Claim 21 further recites "a statistics component to receive and store statistic reports on activity of said instant messaging user in selecting said business information of said business." The Office Action sets forth that the act of determining an incentive is a statistical analysis that is inherently displayed. Applicant respectfully disagrees with this interpretation. Paragraph [0202] has nothing to do with a statistics component to receive and store statistic reports on activity of instant messaging users in selecting business information.

Independent claim 28 currently recites a method of advertising comprising: (1) sending presence information, *including physical locations information*, to a visiting instant messaging user who visits a business and to one or more instant messaging users who list said visitor on an instant messaging address list; and (2) displaying part of said presence information to said visiting instant messaging user and to said one or more instant messenger users, wherein said part of said presence information includes a link to advertisements for said business. As discussed with regard to claims 1 and 21, Mitsuoka's icons do not include any form of physical location information. The Office Action points to Mitsuoka paragraphs [0016-0018] and [0026-0027] as teaching the above claim limitations. However, Mitsuoka in general, and these paragraphs in particular, do not disclose sending presence information to a "visiting instant messaging user" who "visits a business" and to "one or more instant messaging users who list said visitor on an instant messaging address list." Moreover, Mitsuoka fails to teach displaying part of the presence information to a "visiting instant messaging user" and to said one or more instant messenger users, wherein said part of said presence information includes a "link to advertisements for said business."

Independent claim 32 currently recites a system for real time instant presence with advertising including a device at a business location for receiving real time presence information, *including physical location information*. As discussed with regard to claims 1, 21, and 28, Mitsuoka's icons do not include any form of location information. In addition, claim 32 recites that: (1) each of the additional instant messaging user devices has an instant messaging address

list containing the instant messaging identity of the first instant messaging user; and (2) wherein the address list is controlled by the additional instant messaging users and the presence information displayed for said members of the address list is under control of the instant messaging client software. Neither of these recitations is disclosed by Mitsuoka. The Office Action indicates that the first recitation is taught in paragraph [0127] of Mitsuoka. However, this paragraph merely provides that "users can copy icons that the users do not own from status icon display of other users in a buddy list and add them to owned icons." This does not expressly or implicitly indicate that "each of the additional instant messaging user devices has an instant messaging address list containing the instant messaging identity of the first instant messaging user," as recited in claim 32. In addition, there is no indication by Mitsuoka that the address list is controlled by the additional instant messaging users and that the presence information is displayed for the members of the address list, as also recited in claim 32.

In view of the above, it is respectfully submitted that Mitsuoka fails to anticipate independent claims 1, 21, 28 and 32. Claims 2, 4-6, 8-20, 22-27, 29-31, and 33-36 are not anticipated by Mitsuoka by virtue of their dependence from one of the independent claims.

**Rejection Under 35 U.S.C. § 103(a)**

Claim 26 is rejected as being unpatentable over Mitsuoka. Claim 26 depends from independent claim 21, which is distinguished from Mitsuoka as set forth hereinabove.

In view of the above, it is respectfully submitted that Mitsuoka fails to render obvious claim 26.

Claims 7, 30, and 31 are rejected as being unpatentable over Mitsuoka in view of Otani U.S. Patent App. No. 2002/0065718. Claim 7 depends from independent claim 1, which is distinguished from Mitsuoka as set forth hereinabove. Claims 30 and 31 depend from independent claim 28, which is distinguished from Mitsuoka as set forth hereinabove. Otani fails to cure the deficiencies of Mitsuoka.

In view of the above, it is respectfully submitted that Mitsuoka in view of Otani fails to render obvious claims 7, 30, and 31.

**Conclusion**

Based on the foregoing, favorable reconsideration and allowance of claims 1, 2 and 4-36 is solicited. If necessary, the Commissioner is hereby authorized in this and concurrent replies to charge payment (or credit any overpayment) to Deposit Account No. 19-1853 for any additional required fees.

Respectfully submitted,

Date: May 17, 2007

By: 

David E. Heisey  
Attorney for Applicant(s)  
Reg. No. 42,651

SHEPPARD MULLIN RICHTER &  
HAMPTON LLP  
333 S. Hope Street, 48<sup>th</sup> Floor  
Los Angeles, CA 90071  
Telephone No.: (858) 720-8936  
Facsimile No.: (858) 509-3691